Upon entry of this First Response, claims 1-23 are pending in this application. Claims 1, 2, 4, 5-7, 9-11, and 13-15 are directly amended herein, and claims 21-23 are newly added. Furthermore, the specification has been amended to comply with requirements made in the outstanding Office Action. It is believed that the foregoing amendments add no new matter to the present application.

Objections to Drawings

The Office Action Summary, PTO-326, indicates that the drawing figures are objected to by the Examiner. In a telephone conversation, the Examiner clarified that the objection was due to an ambiguity in the detailed description of the invention on page 8, line 11 that stated "processor 302," and the figure to which the element related illustrated a "processor 402." The discrepancy has been remedied in the specification. Therefore, Applicant respectfully requests that the objection to the drawings be withdrawn.

Response to §103 Rejections

In order for a claim to be properly rejected under 35 U.S.C. §103, the combined teachings of the prior art references must suggest all features of the claimed invention to one of ordinary skill in the art. See, e.g., In Re Dow Chemical, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988), and In re Keller, 208 U.S.P.Q. 871, 881 (C.C.P.A. 1981). In addition, "(t)he PTO has the burden under section 103 to establish a prima facie case of obviousness." In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988). Furthermore, the Federal Circuit has stated that "(i)t is impermissible, however, to simply engage in hindsight reconstruction of the claimed invention, using the applicant's structure as a template and selecting elements from references to fill the gaps." In re Gorman, 933 F.2d 982, 987, 18 U.S.P.Q.2d 1885 (1991).

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Claim 1

Claim 1 presently stands rejected under 35 U.S.C. §103 as purportedly being

unpatentable over *Mori* in view of *Housel*. Amended Claim 1 presently reads as follows:

> 1.   A method for printing information comprising:
> storing information corresponding to a print task in
> memory in a print-ready format, the information in the
> print-ready format being configured for use by a printing
> device such that the information can be printed by the
> printing device without being processed by a driver of the
> printing device; and
> *enabling a selected portion of the print-ready*
> *information to be printed without printing a non-selected*
> *portion of the print-ready information.* (Emphasis added).

Applicant respectfully asserts that the cited art is inadequate to render pending claim 1 obvious.

In particular, the cited art fails to suggest or teach at least the features of pending claim 1

highlighted hereinabove.

The Office Action states that "*Mori* does not specifically teach [a] printing

system configured to enable the selcted portion of the print task to be printed without

printing a non-selected portion of the print task." See Officc Action, page 4. However,

the Office Action asserts that *Housel* does teach a printing system exhibiting this feature,

and Applicant respectfully traverses this assertion.

In this regard, *Housel* appears to generally teach a printing system that permits a user to

select certain pages of a print task to be printing on selected mediums. However, it does not

appear that the print task is "print-ready information." To the contrary, *Housel* specifically

teaches allowing a user to select the particular pages and associated mediums at the printer

interface, See Housel, paragraph 27, lines 1-5, and, thereafter, the "central processing unit 17

converts the information …into printer-readable language for the printer."

Therefore, it does not appear that *Housel* teaches or suggests "enabling a selected

portion of the print-ready information to be printed without printing a non-selected portion of

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the print-ready information," as claimed in claim 1. Accordingly, Applicant submits that the Office Action fails to overcome its burden of establishing that each of the combination of features highlighted hereinabove for claim 1 is suggested or taught by the cited art.

For at least the foregoing reasons, Applicant submits that the 35 U.S.C. §103 rejection of claim 1 is improper and should be withdrawn.

No Motivation to Combine

In addition, in rejecting pending claim 1, it is asserted in the Office Action that:

> "[I]t would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the invention of *Mori* to permit the user to print only a selected portion of a print task since *Housel et al.* Teaches that this structure enables the users to easily designate their desired print jobs when inputting their request commands at the printer."

However, Applicant respectfully asserts this alleged motivation for combining *Mori* with *Housel* is inadequate.

In this regard, the Office Action fails to cite a specific teaching in the cited art showing that the alleged motivation for combining *Mori* with *Housel* is suggested by the cited art. "There must be some reason, suggestion, or motivation *in the prior art* whereby a person of ordinary skill in the field of the invention would make the combination." *In re Oetiker*, 977 F.2d 1443, 1447, 24 U.S.P.Q.2d 1443 (Fed. Cir. 1992)(emphasis added). Moreover, Applicant submits that the aforementioned reason proffered in the Office Action for combining *Mori* with *Housel* is not gleaned from the cited art but is instead based on improper hindsight reconstruction of Applicant's invention. As a result, the combination of *Mori* and *Housel* to reject pending claim 1 under 35 U.S.C. §103 is improper.

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Claims 2-9 and 21-23

Claims 2-9 presently stand rejected in the Office Action under 35 U.S.C. §103 as allegedly being unpatentable over *Mori in view of Housel*. Further, claims 21-23 have been newly added via the amendments set forth herein. Applicant submits that the pending dependent claims 209 and 21-23 contain all features of their respective independent claim 1. Since claim 1 should be allowed, as argued hereinabove, pending dependent claims 2-9 and 21-23 should be allowed as a matter of law for at least this reason. *In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988).

Claim 10

Claim 10 presently stands rejected under 35 U.S.C. §103 as purportedly being unpatentable over *Mori* in view of *Housel*. Amended claim 10 presently reads as follows:

> 10.   A print system comprising:
>
>   a job retention system configured to receive an input corresponding to a selected portion of print-ready information and retrieve information corresponding to the selected portion of the print-ready information, the information being in a print-ready format configured for use by a printing device such that the information can be printed by the printing device without being processed by a driver of the printing device, *the job retention system being further configured to enable the selected portion of the print-ready information to be printed without printing a non-selected portion of the print-ready information*. (Emphasis added).

For at least the reasons set forth hereinabove in the arguments for allowance of claim 1, Applicant submits that the cited art fails to suggest or teach at least the features of claim 10 highlighted hereinabove. Therefore, the 35 U.S.C. §103 rejection of claim 10 is improper and should be withdrawn.

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Claims 12-20

Claims 12-20 presently stand rejected in the Office Action under 35 U.S.C. §103 as allegedly being unpatentable over *Mori in view of Housel*. Further, claim 22 has been added via the amendment set forth herein. Applicant submits that the pending dependent claims 12-20 and 22 contain all features of their respective independent claim 10. Since claim 10 should be allowed, as argued hereinabove, pending dependent claims 12-20 and 22 should be allowed as a matter of law for at least this reason. *In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988).

CONCLUSION

Applicant respectfully requests that all outstanding objections and rejections be withdrawn and that this application and all presently pending claims be allowed to issue. If the Examiner has any questions or comments regarding Applicant's response, the Examiner is encouraged to telephone Applicant's undersigned counsel.

Respectfully submitted,

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<u>ANNOTATED VERSON OF THE</u>

<u>AMENDED CLAIMS</u>

1.   A method for printing information comprising:

storing information corresponding to a print task in memory in a print-ready format,

the information in the print-ready format being configured for use by a printing device such

that the information can be printed by the printing device without being processed by a driver

of the printing device; and

enabling a selected portion of the **[print task]**print-ready information to be printed

without printing a non-selected portion of the **[print task]** print-ready information.

2.   The method of claim 1, further comprising:

providing a printing device; and

printing the selected portion of the **[print task]**print-ready information using the

printing device.

4.   The method of claim 1, further comprising:

receiving an input corresponding to a user's intent to print only a portion of the **[print**

task]print-ready information; and

enabling only the selected portion of the **[print task]**print-ready information to be

printed.

5.   The method of claim 4, further comprising:

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receiving an input corresponding to a user's intent to print the entire **[print task]**print-ready information; and

enabling the entire **[print task]**print-ready information to be printed.

6.   The method of claim 4, further comprising:

enabling the user to select at least the portion of the **[print task]**print-ready information to be printed.

7.   The method of claim 6, wherein the printing device has a user interface; and

wherein enabling the user to select at least the portion of the **[print task]**print-ready information comprises:

enabling the user to select at least the portion of the **[print task]**print-ready information via the user interface.

9.   The method of claim 6, further comprising:

providing a driver, the driver being configured to receive information and configure the information in the print-ready format, the driver being further configured to provide a graphical user interface; and

wherein enabling the user to select at least the portion of the **[print task]**print-ready information comprises:

enabling the user to select at least the portion of the **[print task]**print-ready information via the graphical user interface.

10.   A print system comprising:

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a job retention system configured to receive an input corresponding to a selected portion of [a **print task**]print-ready information and retrieve information corresponding to the selected portion of the [**print task**]print-ready information, the information being in a print-ready format configured for use by a printing device such that the information can be printed by the printing device without being processed by a driver of the printing device, the job retention system being further configured to enable the selected portion of the [**print task**]print-ready information to be printed without printing a non-selected portion of the [**print task**]print-ready information.

11. The print system of claim 10, further comprising:

a printing device having a memory, the information corresponding to the [**print task**]print-ready information being stored in the memory of the printing device; and

wherein the job retention system resides in the printing device.

13. The print system of claim 10, wherein the printing device includes a user interface, the user interface being configured to enable a user to select at least the portion of the [**print task**]print-ready information.

14. The print system of claim 11, further comprising:

a workstation communicatively coupled to the printing device, the workstation having a driver, the driver being configured to configure information in the print-ready format and provide the print-ready format information to the printing device, the driver being further configured to provide a graphical user interface, the graphical user interface being configured to enable the user to select at least the portion of the [**print task**]print-ready information.

15. The print system of claim 10, further comprising:

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a workstation having a driver configured to provide a graphical user interface, the

graphical user interface being configured to enable a user to select at least the portion of the

[print task]print-ready information.

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